



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,913	10/19/2001	Kazunori Sato	A322-1	7289
30743	7590	03/23/2006	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			WU, RUTAO	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/981,913		SATO, KAZUNORI	
	Examiner		Art Unit	
	Rutao Wu		3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8,11-16,18-22,24-26,29-34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8,11-16,18-22,24-26,29-34 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. In response filed January 18, 2006 the applicant amended claims 1, 2, 6, 7, 14, 15, 18, 19, 24, 32, 33, and 36 and cancelled claims 5, 9, 10, 17, 23, 27, 28 and 35.

Now new claims have been filed.

Response to Arguments

2. The applicant's indicates the drawings filed with the application on October 19, 2001 were deemed as being informal by the Examiner. The Examiner notes here that no objections to the drawings were filed with the original office action.

3. Applicant's arguments filed January 18, 2006 have been fully considered but they are not persuasive.

4. The applicant amended independent claim 1 to include the limitations in the cancelled claims 5 and 9. Independent claim 7 has been amended to include the limitations in the cancelled claims 5, 9 and 10. Independent claim 14 has been amended to include the limitations in the cancelled claims 9 and 17. Independent claim 19 has been amended to include the limitations in the cancelled claims 9 and 23. Independent claim 25 has been amended to include the limitations in the cancelled claims 27, 28 and 35.

Art Unit: 3639

5. With regards to the amended claims 1 and 14, the applicant argues that Crosskey et al does not meet the limitation of "a person who has made an accounting contract in advance with a provider having said data sever and said calculator"

Crosskey et al disclose a system of multiparty billing where content providers, online service providers, and users can all be charged independently or together for accessing online services. Crosskey et al disclose "the present invention provides for a system and method for billing one or more participating parties for client access to the internet." (col 3: lines 27-29) Even though Crosskey et al does not state that the one or more participating parties has made an accounting contract in advance with a provider, it is obvious to one skilled in the art from Crosskey et al's disclosure that the participating parties must make an agreement or a contract to agree to be billed for client's access to the internet. If an agreement or a contact was not made prior to getting billed by the system disclosed by Crosskey et al then the participating parties would not be "participating parties" because they wouldn't be involved, nor would have to have pay the bills, thus rendering the whole invention useless. Also note MPEP § 2144.01 which states "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." Therefore, Crosskey et al does teach "a person who has made an accounting contract in advance with a provider having said data server and said calculator."

The applicant also argues that Crosskey et al does not teach the limitation of "a specific code is applied to the data by the data transmitter."

Crosskey et al disclose that Web pages can be used to display billing responsibility of the users for accessing the Web (col 2: lines 62-63), the system provides an indication, through a client interface on a source web page, whether a client will be responsible for payment of a billing amount for access to a target web page. This indication is preferably accomplished by presenting different appearances of object linkages indicating whether the client is responsible for the payment of a billing amount and indicating the billing amount to the client. (col 4: lines 3-7) Crosskey et al further disclose that to permit bill sharing, a hyperlink access pair $HAP(user_id, session_id, hap_id) = (V_current_stop, V_next_stop)$ is mapped into a set of payments denoted by $Pay(HAP) = \{pay(user_id), pay(OLSP_id), pay(advertiser_id), pay(contentprovider_n), \dots etc\}$. (col 6: lines 25-29) Both hyperlink source and hyperlink target are typically represented by a universal resource identifier (URI) or universal resource locator (URL) in HTTP and, as described, they together form a hyperlink access pair. (col 6: lines 58-60) Therefore, it is inherent from the disclosure that content providers embed their id (code) in the URL (which in itself is also a code) attached to their data to inform the Online Service Provider to bill them for user access.

6. With regards to amended claim 7, see explanations supra. The applicant argues that Crosskey et al does not teach "said data server removes said specific code from said data, transmits said data to said data receiver"

From the above explanations, Crosskey et al embeds ids(codes) that distinguish which party are responsible for billing in the URL that is associated with the wanted data. Client access the URL to receive the data and the Online Service Provider uses

Art Unit: 3639

URL to bill the identified party(ies) (col 7: lines 1-5) Therefore, it is obvious to one skilled in the art to see that the user access a URL embedded with identification information (code) to retrieve the wanted data, the Online Service Provider strips the URL with billing identification information and sends the user the data, such as pictures, advertisements, or electronic messages. Therefore Crosskey et al teaches "said data server removes said specific doe from said data, transmits said data to said data receiver."

7. With regards to amended claims 19 and 32, see explanations supra. The applicant argues that Crosskey et al does not teach "checking whether said data transmitter is a person who has made an accounting contract in advance with a provider having said data server and said calculator" and "checking whether said data transmitter has attached a specific code to said data."

Crosskey et al's invention identifies and bills at least one of the one or more participating parties for client access to the internet. (col 3: lines 27-28) It has been established supra that participating parties are person who has made an accounting contract in advance with a provider having said data server and said calculator. Therefore, it is inherent that Crosskey et al's invention check to see if the content provider is a participating party before billing the party for client access.

It is also an inherent feature that Crosskey et al's invention check whether said data transmitter has attached a specific code to said data. From the explanations supra, the invention uses id codes embedded in the URL of the content provider to

identify the responsible billing party. Therefore the invention must check if the code is present to know which content provider to bill the usage fee to.

8. With regards to amended claim 25, see explanations supra. The applicant argues that Crosskey et al does not teach "(a) making a request to a charger to assign said specific code to said data transmitter, said step (a) being to be carried out by said data transmitter; (b) assigning said specific code to said data transmitter in response to said request, said step (b) being to be carried out by said charger; (c) applying said specific code to said data, said step (f) being carried out by said data transmitter;"

Crosskey et al disclose that each responsible party is assigned an id. (col 6: lines 27-29) It is inherent by the disclosure provided that the Online Service Provider provides content providers, when they agree to be participating parties, an assigned identification id. From well known practices in the art, when a content provider sign up or agrees to be a participating party to be responsible for billing the server that manages such billing (in this case, the Online Service Provider) would provide the content provider with an identification id so to enable identification of the responsible billing party. Therefore, the content provider would request an identification id when signing up, and the Online service provider would assign an identification id to the content provider. The Online service provider is the only one that can assign identification ids because they need to keep track of the participating content providers to ensure proper identifications can be achieved. Then it is up to the content provider to associate the identification id with the data they provide to enable correct billing of such data access, as disclosed by Crosskey et al, "the original content provider may be willing to absorb

Art Unit: 3639

the accessing cost for the user if the page is an advertisement.” (col 6: lines 20-22) The association of identification id to data must be done by the content provider because they are the only ones that can decide what they are willing to get billed for and what they want their clients to get billed for.

From the above arguments, independent claims 1, 7, 14, 19, 25, 32 and their associated depended claims stand rejected.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4, 6-8, 11-16, 18-22, 24-26, 29-34, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat No. 6,035,281 to Crosskey et al.

Referring to claims 1 and 14:

An accounting system used for a wireless communication system in which a data transmitter transmits data to a data receiver through a network, comprising:

(a) a data server storing therein data transmitted from said data transmitter; and

(col 5: lines 1-5)

(b) a calculator calculating a fee payable to communication between said data transmitter and said data receiver, (col 4: lines 59-63)

wherein when said data receiver receives data stored in said data server, if said data transmitter is a person who has made an accounting contract in advance with a provider having said data server and said calculator and a specific code is applied to the data by the data transmitter, said calculator charges said data transmitter for communication between said data transmitter and said data receiver. (col 3: lines 29-35; col 4: lines 18-22)

Even though Crosskey et al does not state that the one or more participating parties has made an accounting contract in advance with a provider, it is obvious to one skilled in the art from Crosskey et al's disclosure that the participating parties must make an agreement or a contract to agree to be billed for client's access to the internet. If an agreement or a contract was not made prior to getting billed by the system disclosed by Crosskey et al then the participating parties would not be "participating parties" because they wouldn't be involved, nor would have to have pay the bills, thus rendering the whole invention useless. Also note MPEP § 2144.01 which states "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom."

Referring to claims 2, 15, 33:

The accounting system as set forth in claim 1, wherein said calculator charges said data receiver for said communication, if said data transmitter is not said person who has made an accounting contract in advance. (col 4: lines 1-2; col 6: lines 20-22)

Referring to claims 3, 16, 21, 30, 34:

The accounting system as set forth in claim 1, wherein said communication is packet communication, and said fee is calculated by said calculator in accordance with packet counts. (col 3: lines 41-45)

Referring to claims 4, 13, 22, 31:

Crossket et al disclose that the server stores hypertext objects, such as HTML files, graphical icon files (e. g. GIF files), audio, video objects and CGI programs, on its local disk and provides these objects to various clients using HTTP through the Internet. (col 5: lines 1-5)

Crossket et al did not explicitly state that data transferred between the servers are e-mails.

However, the difference between the information Crossket et al disclosed as stored in the server and e-mails are only found in the non-functional descriptive material and are not functionally involved in the steps recited. The receiving, storing and providing steps would be performed the same regardless of the descriptive material since none of the steps explicitly interact therewith. Limitations that are not functionally interrelated with the useful acts, structure, or properties of the claimed invention carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would also have been obvious to a person of ordinary skill in the art at the time of applicant's invention to transfer and storing e-mails between servers and

users because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claims 6, 18, 24, 36:

The accounting system as set forth in claim 1, wherein when said data receiver receives data stored in said data server, said data server makes judgment as to whether said data transmitter is a person who has made an accounting contract in advance, and, if said data transmitter is said person who has made an accounting contract in advance, said data server informs said calculator that said data transmitter is said person who has made an accounting contract in advance, and of an amount of data having been transmitted to said data receiver from said data transmitter. (col 3: lines 29-35; col 4: lines 18-22; col 5: lines 61-63)

Referring to claim 7:

An accounting system used for a wireless communication system in which a data transmitter transmits data to a data receiver through a network, comprising:

(a) a data server storing therein data transmitted from said data transmitter; and
(col 5: lines 1-5)

(b) a calculator calculating a fee payable to communication between said data transmitter and said data receiver, (col 4: lines 59-63)

wherein said data transmitter has made an accounting contract in advance with a provider having said data server and said calculator and wherein a specific code is

provided to said data transmitter from said data server upon a request by the data transmitter to use the account system, (see explanations supra) when said data receiver receives data stored in said data server, if a specific code is attached to said data by said data transmitter, said data server removes said specific code from said data, transmits said data to said data receiver, and said calculator charges said data transmitter for communication between said data transmitter and said data receiver. (col 6: lines 18-34)

From the above explanations, Crosskey et al embeds ids(codes) that distinguish which party are responsible for billing in the URL that is associated with the wanted data. Client access the URL to receive the data and the Online Service Provider uses URL to bill the identified party(ies) (col 7: lines 1-5) Therefore, it is obvious to one skilled in the art to see that the user access a URL embedded with identification information (code) to retrieve the wanted data, the Online Service Provider strips the URL with billing identification information to identify the responsible bill party (col 6-11) and sends the user the data, such as pictures, advertisements, or electronic messages.

Referring to claims 8, 26:

The accounting system s set forth in claim 7, wherein said specific code is comprised of a ciphered code. (col 6: lines 28-33)

Referring to claim 11:

The accounting system as set forth in claim 7, wherein said calculator charges said data receiver for said data, if said specific code is not attached to said data. (col 6: lines 18-34)

Referring to claim 12:

The accounting system as set forth in claim 7, wherein said communication is packet communication and said fee is calculated by said calculator in accordance with packet counts. (col 3: lines 41-45)

Referring to claims 19 and 32:

A method of settling accounts in a wireless communication system in which a data transmitter transmits data to a data receiver through a network, comprising the steps of:

(a) calculating a fee payable to communication between said data transmitter and said data receiver; (col 4: lines 59-63)

(b) checking whether said data transmitter is a person who has made an accounting contract in advance with a provider having said data server and said calculator; and (col 3: lines 29-31; col 4: lines 18-22, see explanations supra)

(c) checking whether said data transmitter has attached a specific code to said data; and (col 6: lines 18-34; see explanations supra)

(d) charging said data transmitter for said communication, if said data transmitter is said person who has made an accounting contract in advance and said specific code is attached to said data. (col 3: lines 31-35; col 5: lines 61-63)

Referring to claim 20:

The method as set forth in claim 19, further comprising the step of charging said data receiver for said communication, if said data transmitter is not said predetermined one. (col 4: lines 1-2; col 6: lines 20-22)

Referring to claim 25:

A method of settling accounts in a wireless communication system in which a data transmitter transmits data to a data receiver through a network, comprising the steps of:

(a) making a request to a charger to assign said specific code to said data transmitter, said step (a) being to be carried out by said data transmitter; (col 6: lines 18-34; see explanations supra)

(b) assigning said specific code to said data transmitter in response to said request, said step (b) being to be carried out by said charger; (col 6: lines 18-34; see explanations supra)

(c) applying said specific code to said data, said step (f) being carried out by said data transmitter; (col 6: lines 18-34; see explanations supra)

(d) calculating a fee payable to communication between said data transmitter and said data receiver; (col 4: lines 59-63)

(e) checking whether a specific code is attached to data by said data transmitter; and (col 6: lines 18-34)

(f) charging said data transmitter for said communication, if said specific code is attached to said data. (col 6: lines 18-34)

(g) removing said specific code from said data; and (col 6: lines 18-34; see explanations supra)

(h) transmitting said data to said data receiver without said specific code. (col 6: lines 18-34; see explanations supra)

From the above explanations, Crosskey et al embeds ids(codes) that distinguish which party are responsible for billing in the URL that is associated with the wanted data. Client access the URL to receive the data and the Online Service Provider uses URL to bill the identified party(ies) (col 7: lines 1-5) Therefore, it is obvious to one skilled in the art to see that the user access a URL embedded with identification information (code) to retrieve the wanted data, the Online Service Provider strips the URL with billing identification information to identify the responsible bill party (col 6-11) and sends the user the data, such as pictures, advertisements, or electronic messages.

Referring to claim 29:

The method as set forth in claim 25, further comprising the step of charging said data receiver for said data, if said specific code is not attached to said data. (col 6: lines 22-34)

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3639

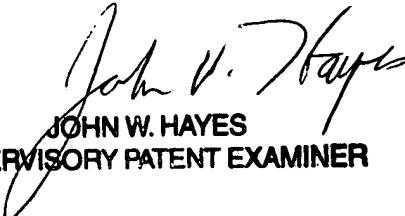
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rutao Wu whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rw


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER